

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Claims 1-12, 7-12, 15-19, and 21 are pending. Claims 13, 14, and 20 are cancelled.

### **II. Remarks Regarding the 35 U.S.C. § 103(a) Rejection**

Claims 1-5, 7-12, 15-19, and 21 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,765,488 issued to Pence *et al.* [hereinafter *Pence*] in view of U.S. Patent No. 5,271,466 issued to Harms et al. [hereinafter *Harms*]. Applicants respectfully traverse.

As to independent claims 1 and 8, Applicants respectfully submit that *Pence* and *Harms* fail to make a prima facie case of obviousness. A prima facie case of obviousness, when based on a combination of references, requires a suggestion or motivation in the prior art references that would lead a person of ordinary skill in the art to make the specific combination of elements claimed by Applicants. M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)). The cited prior art references contain no such motivation or suggestion to combine the elements of *Pence* and *Harms* to arrive at the specific combination of elements claimed by Applicants. Thus, Applicants respectfully submit that combining references, *Pence* and *Harms*, would be an inappropriate combination of references.

Applicants' method of specifically using a non-crosslinked fluid as the first fluid to fracture the formation has several advantages. One advantage of using a non-crosslinked fluid is that less polymer may be used for the treatment job overall thereby reducing cost. Further, by using less polymer, formation damage to the formation may be minimized. That is, using a non-crosslinked fluid as the first fluid may reduce damage to the formation by, in part, producing smaller sized fractures than those fractures that would be otherwise produced by using a crosslinked fluid as the first fluid.

Examiner writes, in part, as follows:

As it would be advantage to enhance the proppant placement and fluid clean up and minimize formation damage it would be obvious to one of ordinary skill in the art to modify the method disclosed by Pence to add a second fluid as taught by Harms. . . . As it would be advantage to enhance the proppant placement and fluid clean up and minimize formation damage it would be obvious to one of ordinary skill in the art to modify the method disclosed by Pence to add a second fluid as taught by Harms.

*See Final Office Action* at 4. As provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. To the extent that Examiner relies on such a statement to supply the necessary motivation to modify the prior art reference, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the modification to the prior art to arrive at the specific combination of elements in Applicants' invention.

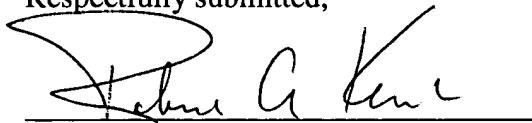
Thus, for at least these reasons, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection as to independent claims 1 and 8 and correspondingly, dependent claims 2-5, 7-12, 15-19, and 21, which depend, either directly or indirectly, from independent claims 1 and 8.

## **SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, the Commissioner is authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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